

REMARKS

Claims 3-5, 16-22, 34, 36-38, 40, 41, and 43-68 are pending. Claims 5, 17, 18, 34, 36, 43, 44, and 47 have been amended. Claims 3, 16, 19-22, 37, 38, 40, 41, 45, and 46 have been previously presented. Claim 4 is original. Claims 48-68 are new. Claims 1, 2, 6-15, 23-33, 35, 39, and 42 have been canceled. Support for new claims 48-68 can be found in original claims 6-15 and 23-33. No new matter or new issue has been introduced by the amendment.

1. Summary of Telephonic Interview with the Examiner on April 26, 2011

The Applicant's representative appreciates the Examiner's time in a telephonic interview on April 26, 2011 regarding rejoinder of non-elected, original claims 6-15 and 23-33, which were canceled during prosecution, in view of the Examiner's statement of reasons for allowance for claims 3, 4, 16, 19-22, 37, 38, 40, 45 and 46 (Office Action, page 3). The Examiner indicated that the non-elected, original claims 6-15 and 23-33 would be rejoined if the Applicant presented these claims as new claims in response to the outstanding Office Action. The general thrust of the principal arguments presented in the interview is repeated in the arguments below.

2. Claim Rejection under 35 U.S.C. § 112, First Paragraph

Claims 5, 17, 18, 34, 36, 41, 43, 44, and 47 have been rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The Examiner asserted that the recitation of "and combinations thereof" failed to comply with the written description requirement (Office Action, page 2). In order to expedite the prosecution, the language "and combinations thereof" has been deleted.

In view of the above, the Applicant respectfully submits that the rejection of claims 5, 17, 18, 34, 36, 41, 43, 44, and 47 has been overcome and should be withdrawn.

Further, the Applicant notes that these claims use the term “comprising” and are thus open to the addition of additional compounds beside those specifically listed. Thus, if more than one member of the Markush group were included, the composition would still be covered by the claims. For example, in amended claim 5, if both a catalyst and a pharmaceutical were included in the discontinuous phase, the amended claim 5 would read on the composition of matter because it includes at least one member of the Markush group, and because the inclusion of a second member of the Markush group can be present without taking the composition outside the scope of the claim due to the claim using the transitional phrase “comprising”.

3. Allowable Subject Matter

The Applicant notes with appreciation that claims 3, 4, 16, 19-22, 37, 38, 40, 45, and 46 are allowed.

4. Rejoinder of Non-Elected Claims

The Examiner issued a restriction requirement under 35 U.S.C. §121, 372, and PCT Rule §13.1 in the Office Action of March 30, 2010. The Examiner requested an election of Group I, claims 1-5, 16-22 and 34-35; Group II, claims 6-15; and Group III, claims 23-33. The Office Action indicated that the Applicant's representative made a provisional election of Group I, claims 1-5, 16-22 and 34-35, without traverse. The Examiner requested affirmation of the provisional election in a response to the Office

Action. (Office Action of 3/30/2010, page 2.) In the response dated June 30, 2010, the Applicant confirmed the election of Group I, claims 1-5, 16-22 and 34-35 *with traverse* (emphasis added). The Applicant argued that Groups I, II, and III contain common special technical features, and that the restriction requirement should be withdrawn.

In the outstanding Office Action, the Examiner allowed claims 3, 4, 16, 19-22, 37, 38, 40, 45, and 46. The Examiner stated that one of the reasons for allowance, *inter alia*, is that the prior art of record “does not teach or fairly suggest the claimed composition of matter comprising a liquid continuous phase, a liquid discontinuous phase which is substantially immiscible in the continuous phase and a surfactant, wherein the continuous phase has a high volume resistivity, the discontinuous phase is electrically charged and the surfactant is selected to not significantly reduce the volume resistivity of the continuous phase.” (Office Action, page 3; underlining original.) The Applicant note that similar features are recited in independent claims 6 (Group II) and 23 (Group III).

In view of the above, the Applicant again respectfully submits that Groups I, II, and III contain common special technical features, and that the restriction requirement should be withdrawn. The Applicant further respectfully requests that, upon withdrawal of the restriction requirement, new claims 48-68, which correspond to non-elected, original claims 6-15 and 23-33, be rejoined. New claims 48-68, when appropriate, have been rewritten relative to the corresponding original claims in order to conform to U.S. practice.

5. Conclusion

Based on the above, the Applicant respectfully submits that the claims are in condition for allowance. If any issues remain, the Examiner is kindly invited to contact the undersigned attorney to expedite allowance.

Respectfully submitted,

Date: May 4, 2011

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